

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ROLF W. REISGIES

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Appeal No. 2007-2589  
Application No. 10/643,521  
Technology Center 3600

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Decided: September 26, 2007

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Before TERRY J. OWENS, MURRIEL E. CRAWFORD and ANTON W. FETTING, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

The Appellant appeals from a rejection of claims 11-18. Claims 1-10 have been withdrawn from consideration by the Examiner. Claims 11-18 stand rejected under 35 U.S.C. § 103 as follows: claims 11-15 and 17 over Ferris (US 3,019,763) in view of Smith (US 4,250,836), and claims 16 and 18 over Ferris in view of Smith and van der Lely (US 6,044,793). Each of the Appellant's independent

claims (11 and 12) requires “means for adjustably mounting wheels to the carriage body so that the wheels can be moved up and down with respect to the carriage body.”

As set forth in the *Manual of Patent Examining Procedure* (MPEP) § 2181(I) (8<sup>th</sup> ed., rev. 3, Aug. 2005):

A claim limitation will be interpreted to invoke 35 U.S.C. § 112, sixth paragraph, if it meets the following 3-prong analysis:

(A) the claim limitations must use the phrase “means for” or “step for;”

(B) the “means for” or “step for” must be modified by functional language; and

(C) the phrase “means for” or “step for” must not be modified by sufficient structure, material or acts for achieving the specified function.

The Examiner states that “the instant application was not examined in light of the invoking of 35 U.S.C. § 112 6<sup>th</sup> paragraph and as such, the claims must be interpreted as broadly as their terms reasonably allow as per MPEP 2111.01” (Ans. 6).

The Examiner argues (Ans. 2-3):

MPEP 2181 states that a claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets the 3-prong analysis. Claims 11 and 12 do not meet the third prong of this analysis, that being: *the phrase “means for” or “step for” must not be modified by sufficient structure, material or acts for achieving the specified function*. In both independent claims, the “means for adjustably mounting wheels to the carriage” has further been modified by acts for achieving the specified function, i.e. “so that the wheels can be moved up and down”.

The Examiner’s statement that “so that the wheels can be moved up and down” is an act is incorrect. That phrase does not recite an act of moving the wheels up and down. Instead, it is part of the recitation of the function of adjustably mounting wheels to the carriage body so that the wheels can be moved

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up and down with respect to the carriage body. Hence, the Examiner erred in examining the application without invoking 35 U.S.C. § 112, 6<sup>th</sup> paragraph.

We therefore remand the application to the Examiner to examine the claims as invoking the claim construction requirements of 35 U.S.C. § 112, 6<sup>th</sup> paragraph.

**REMANDED**

JRG

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